

**REMARKS**

Claims 1-20 have been rejected under 35 U.S.C. 103 over Ylitalo in view of Subbraraman. The rejection is respectfully traversed.

Ylitalo relates to an ink-jet printing ink which has been designed to overcome a foaming problem when the ink contains surfactants by employing a fluorinated surfactant. The ink contains the fluorinated surfactant, colorant and a vehicle. The composition can also contain a plethora of other materials, one of which could be an energy curable monomer, oligomer or mixture. As the Office Action acknowledges, Ylitalo fails to teach or suggest a solvent-soluble resin is present. The rejection therefore relies upon Subbraraman.

Subbraraman describes a moisture-free, non-pigmented ink "containing only solvents and solvent soluble resins and dyes that exhibit acceptable characteristics of opacity, contrast, adhesion and machine compatibility" in which the "differential solubilities of the resins in the solvent-blend is the prime moving factor of the opacifying action." (Abstract). There is no teaching or suggestion in this reference of the presence of an energy curable monomer, oligomer or mixture. The Subbraraman composition is designed to cure by drying. See, e.g., column 3, line 23, and column 13, line 45 to column 14, line 3.

As the Examiner is aware, there must be some reason to extract some teaching from a secondary reference and incorporate it into the primary reference. The Office Action does not propose such a reason here, but merely sets forth the ultimate conclusion that such a modification would be obvious. Subbraraman employs a solvent-soluble resin in order to realize the optimum balance of adhesion and opacity in a composition which

cures by drying, and there is no apparent reason to incorporate such a resin in a composition which cures by polymerization or cross-linking and therefore requires the presence of a photoinitiator, such as the energy curable compositions of Ylitalo. See [0086].

Since no valid reason exists for extracting a solvent-soluble resin from Subbraraman (or any other reference for that matter) and incorporating it into an energy curable composition, it is respectfully submitted that the combination is improper and the rejection is untenable.

In view of the above remarks, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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